

REMARKS/ARGUMENTS

The following remarks are submitted in response to the Office Action mailed September 27, 2007, setting a three-month shortened statutory period for response ending December 27, 2007. As the result of a provisional election in September of 2007 claims 28-56 have been withdrawn. With this Amendment claims 23, 24, 71, and 72 have been cancelled, and claims 74 and 75 were added. New independent claims 74 and 75 are based on allowed claims 23, 24, 71, and 72. Thus, independent claims 74 and 75 should be in allowable form. Additionally, claims 53, 69 and the specification have been amended to correct clerical errors; no new matter has been added with these amendments. Claims 1-22, 25-70, and 73-75 remain pending in the Application. Reconsideration, examination and allowance of all pending claims are respectfully requested.

Claim Rejections Under 35 U.S.C. §103

In paragraph 6 of the Office Action, the Examiner rejects claims 1-9, 11, 13, 15, 16, 18, 19-21, 25-26, 57, 59, 61, 63-64, 66-68, and 73 under 35 U.S.C. § 103(a) as being unpatentable over *Ren et al.* (U.S. Patent 6,045,547) in view of *Viera* (U.S. Patent 6,039,699). Applicants respectfully traverse this rejection. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See M.P.E.P. §2143.03.

Ren et al. disclose a catheter assembly comprising a multi-layer catheter tube. The Examiner argues that the *Ren et al.* reference teaches “[o]ne catheter tube section [that] has a first, inner layer formed of a flexible material and a second, outer layer formed of a stiffer material” wherein “[t]he outer tube can have a region of substantially constant wall thickness followed distally by a taper which terminates, leaving the inner tube with no outer layer.” However, as stated by the Examiner, *Ren et al.* does not teach or suggest that both portions should be made of metal as recited in independent claim 1, 57, and 73. For this reason, the Examiner argues that because “[V]iera teaches a multi-layer guidewire where each the inner and outer layers are made of metal”, *Viera* overcomes the deficiencies of *Ren et al.* However, after careful review of *Ren et al.*, it appears that the catheter assembly described in this reference does not teaches removing a segment of the metallic outer portion from the

composite shaft to expose a segment of the metallic inner portion. Instead, *Ren et al.* teach a “[p]olymer having different stiffness or flexibility (flexural modulus) when extruded relative to the other polymer” (col 3, lines 20-23). Those skilled in the art recognize the difference between partially extruding a polymer over another polymer to partially expose part of the inner polymer, and removing a segment of the metallic outer portion from the composite shaft to expose a segment of the metallic inner portion as described in the claimed invention. Consequently, inner tube distal portion 32 is not constructed by removing a segment of the metallic outer portion from the composite shaft to expose a segment of the metallic inner portion, but by extruding a polymer relative to the other polymer (col 3, lines 20-23). Moreover, a *prima facie* case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention (See M.P.E.P. § 2144.05 III). The *Ren et al.* reference “teaches away” from removing a segment of the metallic outer portion from the composite shaft to expose a segment of the metallic inner portion. Since the combination of the cited references does not teach each and every element of independent claims 1, 57, and 73, Applicant respectfully submits that claims 1-9, 11, 13, 15, 16, 18, 19-21, 25-26, 57, 59, 61, 63-64, 66-68, and 73 are patentable over the cited references.

In paragraph 7 of the Office Action the Examiner rejects claims 12, 17, 60, and 65 under 35 U.S.C. §103(a) as being unpatentable over *Ren et al.* and *Viera* as applied to claims 1 and 57, and further in view of O'Brien et al. (WO 99/58184). We respectfully traverse this rejection. As stated hereabove, neither *Ren et al.* nor *Viera* appear to teach or suggest removing a segment of the metallic outer portion from the composite shaft to expose a segment of the metallic inner portion as recited in independent claims 1 and 57. Accordingly, since claims 12, 17, 60, and 65 are dependant from independent claims 1 and 57 respectively, these claims are also patentable over the cited art.

Finally, claims 14 and 62 are rejected under 35 U.S.C. §103(a) over *Ren et al.* and *Viera* in view of *Rooney et al.* (U.S. Patent 6,306,105 B1). As stated hereabove, independent claims 1 and 57 recite a distal region of the shaft that has a segment of the metallic outer portion removed from the composite shaft to expose a segment of the metallic inner portion. Neither *Ren et al.* nor *Viera* appear to teach or suggest removing a segment of the metallic outer portion from the composite shaft to expose a segment of the metallic inner portion as

recited in independent claim 1 and 57. *Rooney et al.* does not appear to overcome the deficiencies of *Ren et al.* or *Viera*. Since the cited art fails to suggest or teach removing a segment of the metallic outer portion from the composite shaft to expose a segment of the metallic inner portion, Applicant respectfully asserts that claims 14 and 62, which are dependant from independent claims 1 and 57, are not anticipated by *Ren et al.* and *Viera* in view of *Rooney et al.*

Conclusion

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that the claims are now in condition for allowance, and issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By his attorney,

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